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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,585	12/21/2000	Mark D. Braxton	GP-301127	2035

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EXAMINER

USTARIS, JOSEPH G

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/745,585

Applicant(s)

BRAXTON, MARK D.

Examiner

Joseph G Ustaris

Art Unit

2611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 1 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 . 6) ☐ Other: .

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 1 is objected to because of the following informalities. It is unclear how the entertainment device provides graphic-based games while at the same time performing the other functions relating to compressed movie data. Appropriate correction is required.

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4 is a duplicate of claim 2, thus no further limitations have been added. The examiner will assume that claim 4 is dependent on claim 3 for the received "for-demand entertainment data."

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 9, and 10 recites the limitation "for-demand entertainment data" in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claim.

The examiner will assume that "for-demand entertainment data" is referring to "compressed movie data" as recited in claims 1 and 2.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-10, 12, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Russo (US006025868A).

Regarding claim 1, Russo discloses a stored program pay-per-play system where a controller or "entertainment device" scans or "monitors" program schedules and selects programs or "compressed movie data" to record based on viewer/listener preferences (See column 3 lines 5-25 and column 4 line 20). The controller receives the programs and stores them on a storage unit (See Fig. 2 element 110 and column 7 lines 43-53). The controller provides a list or "plurality of choices" to the viewer or "user" of the stored titles or "stored movie data", where the viewer can select a stored title or "designating a movie choice" to be viewed or played or "designated movie choice to play a movie for the user" (See column 10 line 58 – column 11 line 5). Furthermore,

Russo discloses that this system can be easily adapted to provide video games (See column 3 lines 45-55).

Regarding claim 2, Russo discloses that various criteria may be used within the viewer's preferences to select which programs to be recorded or "stored" (See column 9 line 61 – column 10 line 5).

Claim 3 contains the limitations of claim 1 (wherein programs are also considered "for-demand entertainment data") and is analyzed as previously discussed with respect to that claim. Furthermore, the controller disclosed by Russo also provides conventional video program service or "conventional entertainment" (See column 3 lines 45-55).

Claim 4 contains the limitations of claims 2 and 3 and is analyzed as previously discussed with respect to those claims.

Regarding claim 6, Russo also discloses that the system still performs its functions (scanning and recording) when the system is left unattended or "when the user is not using the entertainment device" (See column 9 lines 48-65).

Regarding claim 7, Russo discloses that the system can be implemented over a satellite system (See column 6 lines 15-25).

Regarding claim 8, the system is capable of recording or "storing" a number of programs or "plurality of movies" (See column 5 lines 55-56 and column 3 lines 45-55).

Regarding claim 9, Russo discloses that the system is also capable for use with audio information or "plurality of audio files" (See column 7 lines 4-15).

Claim 10 contains the limitations of claims 1 and 2 (wherein video games is also considered "plurality of user-interactive games") and is analyzed as previously discussed with respect to those claims.

Claim 12 contains the limitations of claim 2 and is analyzed as previously discussed with respect to that claim.

Claim 13 contains the limitations of claim 1 and is analyzed as previously discussed with respect to that claim.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russo (US006025868A) in view of Blackketter et al. (US 20030204854A1).

Regarding claim 5, Russo discloses a stored program pay-per-play system where a controller or "entertainment device" scans or "monitors" program schedules and selects programs or "compressed movie data" to record based on viewer/listener preferences (See column 3 lines 5-25 and column 4 line 20). The controller receives the programs and stores them on a storage unit (See Fig. 2 element 110 and column 7 lines 43-53). The controller provides a list or "plurality of choices" to the viewer or "user" of the stored titles or "stored movie data", where the viewer can select a stored title or

"designating a movie choice" to be viewed or played or "designated movie choice to play a movie for the user" (See column 10 line 58 – column 11 line 5). Furthermore, Russo discloses that this system can be easily adapted to provide video games (See column 3 lines 45-55). However, Russo lacks a method or system where the controller can monitor the channels as a background function undetectable by the "user" or viewer.

Blackketter et al. discloses a system for enhancing a video cable system. The system provides a means for sending additional information, such as web pages, along with the broadcast video. In order to activate the additional information, the system monitors the channels for a trigger signal. The viewer could be watching a program while the system monitors the current or different channel, thus being undetectable by the user (See paragraph 0021, 0030, and 0038). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the controller disclosed by Russo to be able to monitor the channels without the user knowing, as taught by Blackketter et al., in order to provide the user with a personalized viewing experience without any interruption from the system, which is working in the background.

Regarding claim 11, Blackketter et al. discloses that the broadcast video or "first entertainment" and web pages or "second entertainment" are transmitted to the user via broadcast television signal. The broadcast video is available for viewing or "real-time reception and playing of the entertainment" while the web pages are stored locally or "disallowing real-time playing of the entertainment" (See paragraph 0030). The user

selects the channel they wish to view or "selectively receiving and playing" and a channel they wish to monitor for enhancements or "selectively receiving and storing" (See paragraph 0038). A trigger selects and modifies certain web pages and then presents them to or used to "entertain" the viewer (See paragraph 0021).

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please take note of Del Sesto et al. (US006530084B1) for his method of inserting additional data into the broadcast video.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Ustaris whose telephone number is (703) 305-0377. The examiner can normally be reached on Monday-Friday with alternate Fridays off from 7:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile, can be reached on (703) 305-4380. The fax phone number for this Group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 305-4700.

JGU  
January 20, 2004

  
HAI TRAN  
PATENT EXAMINER